

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte XIAOPING HU and YASSER M. KADAH

Appeal No. 2000-1325
Application No. 08/842,758

ON BRIEF

Before URYNOWICZ, DIXON and SAADAT, Administrative Patent Judges.
URYNOWICZ, Administrative Patent Judge.

Decision on Appeal

This appeal is from the final rejection of claims 1, 2, 4-8 and 10-13.

The invention pertains to a method and apparatus for imaging an object. Claim 1 is illustrative and reads as follows:

1. A process for imaging an object, comprising the steps of:

Appeal No. 2000-1325
Application No. 08/842,758

- (a) exciting the object at a location with radiation having a plurality of different phase encodings to produce M phase-encoded signals of an excited profile of the object;
- (b) repeating step (a) at each of n locations;
- (c) applying a discrete Fourier transform of n slices to produce a K-space signal of the imaged object which is shifted by the amount of applied phase encoding multiplied by the sampled spectrum of the excitation profile, and
- (d) generating an image from said K-space signal.

Claims 1, 2, 4-8 and 10-13 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The respective positions of the examiner and the appellants with regard to the propriety of these rejections are set forth in the final rejection and the examiner's answer (Paper Nos. 12 and 24, respectively) and the appellants' brief and reply brief (Paper Nos. 19 and 21, respectively). The answer incorporates the examiner's statement of the grounds of rejection by reference to the final rejection.

Appellants' Invention

The invention is described at pages 6-8 of the brief.

Appeal No. 2000-1325
Application No. 08/842,758

Opinion

A final rejection shall repeat or state all grounds of rejection considered applicable to the claims in the application, clearly stating the reasons in support thereof. 37 CFR § 1.113(b). Whereas an examiner's answer may, as here, incorporate the statement of the grounds of rejection by reference to the final rejection, (MPEP § 1208, page 1200-17, paragraph A), we have considered examiner's position on appeal to be 1.) the ground of rejection, and reasons in support thereof, set forth in the final rejection and 2.) item (11) at page 3 of the answer.

After consideration of the positions and arguments presented by both the examiner and the appellants, we have concluded that the rejection should not be sustained.

In the answer at page 3, item (11), the examiner states as follows:

Most arguments presented by appellant have been responded to in the Final Rejection of the claims dated March 25, 1999. The additional arguments, pertaining to statements that the rejection is misapplied because the rejection of record refers to a "method" and not an apparatus, is not found persuasive. The method and apparatus clearly correspond to each other, no distinction is made in the rejection for separate inventions.

Appeal No. 2000-1325
Application No. 08/842,758

The examiner's position is set forth at pages 2 and 3 of the final rejection. At page 2, paragraph 2 of that rejection, it is urged that the combination of steps in the claims are not described as a unit in the specification. For example, attention is drawn to the fact that claim 1, step (c), calls for the use of a Fourier transform shifted by the amount of phase encoding multiplied by the sampled spectrum of the excitation profile. It is submitted that this step is not described in the specification, that it is one step in the claim, and that it cannot be identified in the specification, much less the combination of this step with steps a), b) and d).

At page 2, paragraph 3 of the final rejection, the examiner rejected appellants' argument to the effect that the steps of their invention are adequately disclosed in the original claims at pages 17-19 of their specification.

Page 3, lines 10-12, of the final rejection reads:

The examiner submits that the combination of steps where applicant states the invention to be, is not present in the specification only in the claims and that no instruction by the specification is present for the combination of steps.

We are not persuaded by the examiner's position and will not sustain the rejection of claims 1, 2, 4-8 and 10-13. At page 3, lines 10-13, of the answer, cited above, the examiner admitted

that the invention is present in the claims. We find the substance of the admission to be true with respect to the original claims. This is because original claim 1 recites steps (a), (b) and (c) of claim 1 on appeal, and the last recitation of original claim 3 includes generating a spatial-domain reconstruction of the object based on the K-space reconstruction of the imaged object, which recitation corresponds to step (d) of appealed claim 1 that calls for generating an image from a K-space signal¹. Furthermore, because the invention of claim 1 is a process for imaging an object, the last step of the process would be generating an image of the object. Contrary to the examiner's position, the original claims are part of the specification. 35 U.S.C. § 112, second paragraph.

¹ Applying a discrete Fourier transform as defined in step (c) of appealed claim 1 is described in appellants' specification from page 4, line 28, to page 7, line 11. Significantly, it has not been shown that step (c) is not fully described or enabled by this disclosure.

Appeal No. 2000-1325
Application No. 08/842,758

An applicant may rely for disclosure upon the specification with original claims and drawings, as filed. MPEP § 608, first paragraph.

REVERSED

STANLEY M. URYNOWICZ JR.)	
Administrative Patent Judge)	
)	
)	
)	
)	
JOSEPH L. DIXON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

Appeal No. 2000-1325
Application No. 08/842,758

SU/RWK

SCHWEGMAN LUNDBERG
WOESSNER AND KLUTH
P O BOX 2938
MINNEAPOLIS, MN 55402